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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,979	12/14/1999	MARK WILLIAM JAMES FERGUSON	39-196	1874

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EXAMINER

JIANG, DONG

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 02/11/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/459,979

Applicant(s)

FERGUSON, MARK WILLIAM  
JAMES

Examiner

Dong Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 39-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED OFFICE ACTION

In view of the appeal brief filed on 12 November 2002, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Currently, claims 39-43 are pending and under consideration.

#### **Objections and Rejections under 35 U.S.C. 112:**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 40-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 40 is indefinite for the recitation of "a site of wounding", which does not refer to the chronic wound of claim 39.

Claim 41 recites the limitation "wherein between 7,500 and 15,000 IU IFN- $\gamma$ " in lines 1-2. There is insufficient antecedent basis for this limitation in the claim because claim 39 refers only to "stimulators of IFN- $\gamma$ , not IFN- $\gamma$ .

Claim 42 is indefinite because it is unclear what "a partially modified form of IFN- $\gamma$ " refers to, and whether it is sequence or chemical modifications, or something else, and the specification

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does not clearly define such. The metes and bounds of the claim, therefore, cannot be determined.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The factors considered when determining if the disclosure satisfies the enablement requirement and whether any necessary experimentation is "undue" include, but are not limited to: 1) nature of the invention, 2) state of the prior art, 3) relative skill of those in the art, 4) level of predictability in the art, 5) existence of working examples, 6) breadth of claims, 7) amount of direction or guidance by the inventor, and 8) quantity of experimentation needed to make or use the invention. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Claims 39-43 are directed to a method for promoting the healing of a chronic wound using a stimulator of IFN- $\gamma$ . However, the experiment results provided in the specification indicate otherwise. The specification discloses that according to the present invention there is provided an *inhibitor* of IFN- $\gamma$  for use in promoting the healing of wounds and fibrotic disorders with reduced scarring (page 2, the second paragraph, page 3, the third paragraph). The specification further teaches that the experiments undertaken show that *anti*-IFN- $\gamma$  treatment is anti-scarring, improving the quality of dermal architecture (page 9, line 1), whereas all the IFN- $\gamma$ -treated wounds showed increased inflammation and angiogenesis in a dose-dependent manner; and worse than control wounds (page 9, the second paragraph). By 70 and 120 days, high dose IFN- $\gamma$ -treated wounds showed *marked scarring and residual inflammation*, the greater the dose of IFN- $\gamma$ , the greater scarring (page 9, the third paragraph), which does not suggest a positive role of IFN- $\gamma$  in *promoting* the healing of wounds. Further, the specification indicates that the inhibitor of IFN- $\gamma$  may be used in conjunction with a composition for promoting the healing of chronic wounds (page 4, the second paragraph). Assuming the claimed method for promoting

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the healing of a chronic wound with IFN- $\gamma$  worked, according to the teachings in the present specification, an inhibitor of IFN- $\gamma$ , such as an anti-IFN- $\gamma$  antibody could be used in conjunction with IFN- $\gamma$  for promoting the healing of chronic wounds, which would be completely contradictory. As such, the effect of IFN- $\gamma$  on promoting the healing of a chronic wound is unpredictable according to the instant disclosure, thus, a skilled artisan would not know how to use the present invention for the purpose of promoting the healing of a chronic wound. Undue experimentation would be required prior to using the claimed invention.

Due to the large quantity of experimentation necessary to determine the actual role of IFN- $\gamma$  in promoting the healing of a chronic wound, the absence of working examples directed to same, the presence of working examples supporting the otherwise, the lack of predictability, and the complex nature of the invention, undue experimentation would be required of the skilled artisan to use the claimed invention.

Claims 39, 40 and 43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 39, 40 and 43 are directed to a method for promoting the healing of a chronic wound using *a stimulator* of IFN- $\gamma$ . However, the specification merely discloses IFN- $\gamma$  for the treatment of wound, and no other stimulator of IFN- $\gamma$  meeting the limitations of the claims is identified or particularly described.

Vas-Cath Inc. v. Mahurkar, 19USPQ2d 1111, clearly states that “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*.” (See page 1117.) The specification does not “clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” (See *Vas-Cath* at page 1116).

With the exception of IFN- $\gamma$ , the skilled artisan cannot envision the detailed chemical structure of the encompassed stimulators of IFN- $\gamma$ , and therefore conception is not achieved until

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reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

One cannot describe what one has not conceived. See *Fiddes v. Baird*, 30 USPQ2d 1481 at 1483. In *Fiddes*, claims directed to mammalian FGF's were found to be unpatentable due to lack of written description for that broad class. The specification provided only the bovine sequence.

Therefore, no stimulator of IFN- $\gamma$  except IFN- $\gamma$  meets the written description provision of 35 U.S.C. §112, first paragraph. Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 U.S.C. §112 is severable from its enablement provision (see page 1115).

**Conclusion:**

No claim is allowed.

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**Advisory Information:**

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 703-305-1345. The examiner can normally be reached on Monday - Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Dong Jiang, Ph.D.  
Patent Examiner  
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2/4/03

  
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